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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,013	04/12/2007	Wilfried Neuber	03472.000001.	7035
5514 7590 05/12/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
PERENCE, JAMES M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,013

Applicant(s)

NEUBER, WILFRIED

Examiner

JAMES FERENCE

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is a reply to the amendment filed on 04/28/2010. Currently, claims 1, 2, 4 and 5-13 are pending. Claim 3 has been cancelled. No new claims have been added. Therefore, claims 1, 2 and 4-13 remain under consideration.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s):

spring section (claim 1);

engagement section (claim 1);

an annular body having the approximate shape of an oval with two curved sections and two essentially elongated sections connecting these two curved sections to one another (claim 6);

a retaining section located on one elongated section, and the engagement section located on the other elongated section (claim 7); and

an elongated section bearing the engagement section being recessed relative to the ends of the curved sections that are connected by this elongated section.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 112
(As Previously Presented)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 1: In line 3, the phrase, "arranged thereon" is used. It is unclear what elements are being arranged. Appropriate clarification is required. Claims 2, 4-11 and 13 are dependent, directly or indirectly, on claim 1.

Claim Rejections - 35 USC § 102

(As Previously Presented)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by van Buren, Jr. (US Patent No. Re. 30,326) ('van Buren').

Referring to claim 1: As best understood, van Buren provides a cover for a manhole top with a cover body (10) and with at least one locking means (14) arranged on the cover body (as shown in Figs. 1-3), said locking means having a spring section (col. 3, lines 29-30) and, arranged thereon, an engagement section (56a, 56b) that can be brought into engagement with a part of a frame (P; as shown in Fig. 3), wherein the

spring section is attached by each of two ends of the spring section to the cover body (as shown in Fig. 1) and is otherwise separated from the cover body (as shown in Fig. 3), and the engagement section is arranged between the two ends of the spring section (as shown in Fig. 3) and wherein the spring section is designed as an annular body (Fig. 1), which is attached to the cover body by a retaining section (34) that essentially joins the two ends of the spring section (as shown in Figs. 1-3).

It is noted that the limitations, *"for a manhole top with a cover body", "can be brought into engagement with a part of a frame"* and *"designed as an annular body, which is attached to the cover body by a retaining section that essentially joins the two ends of the spring section"* are statements of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is further noted that the claim language, "locking means" does not properly invoke 35 USC 112, sixth paragraph, since the language is drawn to a structural limitation.

Referring to claim 2: van Buren further provides the spring section extending approximately parallel to the cover body (flat portion of 14 as viewed from the side in Fig. 3).

Referring to claim 4: van Buren further provides the annular body having the approximate shape of a circle (see Fig. 1).

Referring to claim 5: As best understood, van Buren further provides the engagement section being arranged at a location essentially diametrically opposite the retaining section (as shown in Fig. 3).

Referring to claim 10: van Buren further provides the locking means being located on the underside of the cover body (as shown in Fig. 3).

Referring to claim 11: van Buren further provides the cover being provided with stiffening ribs (32a, 32b) wherein the locking means are located a distance apart from the stiffening ribs, as best understood, on the cover body (Fig. 1).

Referring to claim 12: As best understood, van Buren provides a manhole top comprising:

- a cover (10) configured according to claim 1; and
- a frame (P) for accommodating the cover (as shown in Fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Buren, Jr. (US Patent No. Re. 30,326) ('van Buren').

Referring to claim 6: van Buren further provides the annular body having an approximate oblong shape with two curved sections and two essentially elongated

sections connecting these two curved sections to one another (col. 3, lines 25-26; Figs. 1-3).

Although van Buren explicitly uses the term "oblong" to describe a different shape or embodiment of the annular body, it should be understood that an oblong circle is generally called an oval. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the shape of the annular body of van Buren by using an oval or oblong shape with two curved sections and two essentially elongated sections connecting these two curved sections to one another. One of ordinary skill in the art would have been motivated to do so in order to adjust the amount of force applied by the spring to lock the cover in place.

Referring to claim 7: van Buren provides all the limitations of claim 6 as above. van Buren does not explicitly show the retaining and engaging sections being located at specific elongated sections. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to arrange the retaining section on one elongated section and the engagement section on the other elongated section, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Referring to claim 8: van Buren further teaches a section bearing the engagement section being recessed relative to the ends of the curved sections (see recessed portion of 56a and 56b; Fig. 3).

Referring to claim 9: van Buren further teaches wherein the engagement section (56a and 56b) has a wedge-shaped (shaped as a wedge, as viewed in Fig. 2) detent

section (56a and 56b include outer portions that engage and resist P', as shown in Fig. 3).

Referring to claim 13: van Buren further teaches the curved sections being semicircular, as best understood (see Fig. 1).

Response to Arguments

Applicant's arguments filed 04/28/2010 have been fully considered but they are not persuasive.

In response to applicant's argument that van Buren is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, van Buren is in the same field of applicant's endeavor (closures or coverings for apertures) in addition to being pertinent to the particular problem with which the applicant was concerned (covering apertures).

In response to applicant's argument that van Buren does not disclose "a spring section that is attached by each of two ends of the spring section to the cover body" or "a spring section that is designed as an annular body, which is attached to the cover body by retaining section that essentially joins the two ends of the spring section", it is first noted that the limitation, "a spring section that is attached by each of two ends of the spring section to the cover body" was treated as the spring section (spring portion of

element 14) that is attached by each of two ends of the spring section (14 left side and 14 right side, as viewed in Fig. 1) to the cover body (P; Fig. 3).

Further, the limitation, "*designed as an annular body, which is attached to the cover body by a retaining section that essentially joins the two ends of the spring section*" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES FERENCÉ whose telephone number is (571) 270-7861. The examiner can normally be reached on Monday - Thursday, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./
Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art
Unit 3635